

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

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PCT

WRITTEN OPINION

(PCT Rule 66)

Date of Mailing
(day/month/year) **05 SEP 2001**

Applicant's or agent's file reference

5269.01

REPLY DUE

within TWO months
from the above date of mailing

International application No.

PCT/US00/29809

International filing date (day/month/year)

27 OCTOBER 2000

Priority date (day/month/year)

27 OCTOBER 1999

International Patent Classification (IPC) or both national classification and IPC
IPC(7): H04N 7/173 and US Cl.: 725/87

Applicant

DISCOVERY COMMUNICATIONS, INC.

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☒ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).~~

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 27 FEBRUARY 2002

Name and mailing address of the IPEA/US

Commissioner of Patents and Trademarks
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WRITTEN OPINION

International application No.

PCT/US00/29809

I. Basis of the opinion

1. With regard to the elements of the international application:*

- ☒ the international application as originally filed
- ☒ the description:
 pages 1-89 , as originally filed
 pages NONE , filed with the demand
 pages NONE , filed with the letter of _____
- ☒ the claims:
 pages 90-102 , as originally filed
 pages NONE , as amended (together with any statement) under Article 19
 pages NONE , filed with the demand
 pages NONE , filed with the letter of _____
- ☒ the drawings:
 pages 1-53 , as originally filed
 pages NONE , filed with the demand
 pages NONE , filed with the letter of _____
- ☒ the sequence listing part of the description:
 pages NONE , as originally filed
 pages NONE , filed with the demand
 pages NONE , filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.
 These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages NONE
- ☒ the claims, Nos. NONE
- ☒ the drawings, sheets/fig NONE

5. ☐ This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".

WRITTEN OPINION

International application No.

PCT/US00/29809

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | |
|-------------------------------|---------------------|-----|
| Novelty (N) | Claims <u>1-37</u> | YES |
| | Claims <u>38-79</u> | NO |
| Inventive Step (IS) | Claims <u>1-37</u> | YES |
| | Claims <u>38-79</u> | NO |
| Industrial Applicability (IA) | Claims <u>1-79</u> | YES |
| | Claims <u>NONE</u> | NO |

2. citations and explanations

Claims 38-79 lack novelty under PCT Article 33(2) as being anticipated by Hendricks (WO 95 95649).

Considering claim 38, Hendricks discloses an apparatus for providing electronic books comprising:

- a) a main memory (600) (figure 6a, 8);
- b) a main interface that receives a request for a main section of an electronic book (see index, menu and/or pages of the book as disclosed on page 18, lines 18-20, figures 10-12);
- c) a main processor that locates the requested main section (628, figure 8).

Claims 38-50 are met by the various sections of the electronic book in figures 1-18b.

Considering claims 51 and 65, Hendricks discloses a computer-readable medium containing instructions for controlling an electronic book delivery system, comprising:

- a) storage module (1040, 1024);
- b) a broadcast module (channel modulators);
- c) an electronic book order module (page 24, line 25, figure 14b, 14d-14f and 14i) that receives and processes orders from the readers.

Claims 52-64 and 66-78 are met by the ordering procedures in association with electronic book stored at the operations center, cable station or library unit disclosed throughout the Hendricks document.

Considering claim 79, Hendricks discloses a user interface for ordering and receiving electronic books comprising:

- a) display window that displays an indication of available electronic books (figure 14c or 14e);
- b) a cost window (figure 14e);
- c) a delivery selection section (14e); and
- d) an order button (figures 14b or 14e, 14f, 14i, 14j)

(Continued on Supplemental Sheet.)

WRITTEN OPINION

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VI. Certain documents cited

1. Certain published documents (Rule 70.10)

| <u>Application No. Patent No.</u> | <u>Publication Date (day/month/year)</u> | <u>Filing Date (day/month/year)</u> | <u>Priority date (valid claim) (day/month/year)</u> |
|---------------------------------------|--|---|---|
| US, A. 6,034,680 | 07 MARCH 2000 | 30 APRIL 1997 | 25 APRIL 1997 |
| US, A. 6,052,717 | 18 APRIL 2000 | 23 OCTOBER 1996 | |

2. Non-written disclosures (Rule 70.9)

| <u>Kind of non-written disclosure</u> | <u>Date of non-written disclosure (day/month/year)</u> | <u>Date of written disclosure referring to non-written disclosure (day/month/year)</u> |
|---------------------------------------|--|--|
| | | |

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

Claims 1-37 meet the criteria set out in PCT Article 33(2)-(4), because the prior art does not teach or fairly suggest a virtual on-demand electronic book system comprising a main memory, a queuing processor, first and second queues or a broadcast module, an electronic book ordering module, a packet assemble module, queue selection module and a queue service module as recited in the claims.

NEW CITATIONS

WO 95 15649 A (HENDRICKS et al.) 08 June 1995, whole document

US 4,855,725 A (FERNANDEZ) 08 August 1989, figures 1-3